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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,227	03/02/2004	Steven Jeffrey Goldberg	I-2-0209.1US	3633

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EXAMINER

TAYLOR, APRIL ALICIA

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/791,227

Applicant(s)

GOLDBERG ET AL.

Examiner

April A. Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12, 21-23 and 25-30 is/are rejected.
- 7) ☒ Claim(s) 6, 13-20, 24 and 31-37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 16 July 2004.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-5, 7-12, 21-23, and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonstromer (US 6,142,369) in view of Taylor (US 5,578,808).

Re claims 1-3, 5, 8, 21-23, 26 and 8: Jonstromer teaches an electronic transaction system comprising a mobile telephone 4, which serves as the calling electronic device as recited in claim 1, for communicating payment data to a network via a communication link; based on the payment data, the network contacts a plurality of

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payer electronic credits or the payer bank account for paying for the communication services; and wherein the payment data is stored in a smart card 7, which serves as a subscriber identity module (SIM) card as recited in claim 2, which is removably inserted into the calling electronic device 4; and storing subscriber authorization data in the calling electronic device requiring that the network requests the user of the calling electronic device 4 to authorize the communications link. (See abstract; figure 2; col. 4, line 10 to col. 6, line 47)

Re claim 4: Jonstromer teaches wherein the payment data entered into the SIM card 7 is transferred to another storage device in the calling electronic device 4 (see col. 4, line 10 to col. 6, line 47).

Re claims 7 and 25: Jonstromer teaches wherein the network comprises a public switched telephone network, which serves as a home public land mobile network (PLMN) as recited in claim 7, servicing the calling electronic device 4, whereby the payment data is stored in a storage device in the calling electronic device 4 (see col. 4, line 10+).

Re claims 9, 10, 27, and 28: Jonstromer teaches a payment provider for providing credit card or debit card services for the calling electronic device 4 and, upon acceptance of the payment request, provides authorization to the network; and wherein the network, upon receipt of the authorization, provides the communications link requested by the calling electronic device 4 (see col. 4, line 10 to col. 6, line 47).

Jonstromer fails to teach or fairly suggest wherein the calling electronic device have access to alternative payment provider data; wherein the network contacts a plurality of alternative providers in order to find one that will accept responsibility for paying for the communication services; and wherein the alternative payment provider data is stored in the SIM card.

Taylor teaches a multi-application smart card for storing alternative payment provider data; and a network for contacting a plurality of alternative providers in order to find one that will accept responsibility for paying for the communication services (see col. 3, line 20 to col. 4, line 60; col. 7, line 3 to col. 8, line 50. In view of Taylor's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to substitute the smart card for storing alternative payment provider data; and a network for contacting a plurality of alternative providers to the teachings of Jonstromer in order to provide an user with multiple payment options and to reduce the number of cards carried by an user.

Re claims 11, 12, 29, and 30: Jonstromer as modified by Taylor fail to teach or fairly suggest wherein a preferred alternative payment provider provides prepaid calling card services. However, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a payment provider for providing prepaid calling card services to the teachings of Jonstromer as modified by Taylor in order to provide multiple services to an user on a single card.

Allowable Subject Matter

5. Claims 6, 13-20, 24, and 31-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, taken alone or in combination, fail to teach or fairly suggest a system for selecting a payment provider to pay for communication services comprising, among other things, a network including a first public land mobile network (PLMN) which is the home network for the calling electronic device and a second PLMN visited by the calling electronic device during a roaming mode, wherein the second PLMN receives the alternative payment provider data from the calling electronic device and forwards the data to the first PLMN for subsequent transfer to a selected one of a plurality of alternative payment providers identified by the alternative payment provider data.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Grunbok, Jr. et al (US 6,305,603) disclose a personal digital assistant based financial transaction system.

Zacharias (US 6,494,367) discloses a multi-application card system.

Hansmann et al (US 2001/0016835) disclose a system for payment in a purchasing action performed by means of a cellular standard communication between a customer and a provider offering goods and/or services.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to April A. Taylor whose telephone number is (571) 272-2403. The examiner can normally be reached on Monday - Friday from 6:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


AAT

18 October 2004

DANIEL STCYR
PRIMARY EXAMINER

